REMARKS

Receipt of the Office Action mailed December 28, 2004 is acknowledged. Claim has been canceled without prejudice or disclaimer. Claim 22 has been amended to incorporate the limitations of claim 18. Claims 19-21 have been amended to correct claim dependency. Upon entry of the amendment, claims 19-22 will be pending in the application. Entry of the amendment is respectfully requested because it reduces the number of issues for appeal. In addition, the amendment is identical to the amendment proposed by the examiner during the telephone interview with the undersigned on December 20, 2004 as set out on page 2 of the Office Action.

Drawings Objections

The Office Action objects to the drawing under 37 CFR 1.83(a). Without acquiescing to the propriety of the objection, applicants submit that in view of the amendment to the claims, this objection has been rendered moot.

35 USC 112, Second Paragraph Rejection

Claim 18 stands rejected under 35 U.S.C. section 112, second paragraph. Reconsideration and withdrawal of the rejections are respectfully requested. The Examiner objects to the term "sufficiently unequal" as not being defined by the claim and not reasonably apprising one of ordinary skill in the art as to the scope of the claimed invention.

As set out in MPEP 2173.05(b) if the term "sufficiently unequal" coupled with the term "cause rotational mixing of liquids..." apprises one of ordinary skill in the art of the scope of the claim, then section 112, second paragraph is satisfied. In this instance, one of ordinary skill in the art need simply to observe the tip and fluid flowing through it. Using techniques known in the art, if rotational mixing is observed, then the tip falls within the scope of the claims. If no rotational mixing is observed, then the tip

is outside of the scope of the claims. Hence, the skilled artisan is apprised of the scope of the claim. To the extent, the objected to language is a functional limitation, applicants point to MPEP 2173.05(g), which directs the PTO to evaluate and consider the limitation just like any other limitation of the claim.

35 U.S.C. Section 102(b) Rejection

Claim 18 stands rejected under 35 U.S.C. section 102(b) as being anticipated by Greenfield (U.S. Patent No. 5,891,397). Reconsideration and withdrawal of the rejection are respectfully requested. The features of claim 18 has been incorporated into claim 22. Thus, the independent claim recites a combination aspirating probe and aspirating probe tip. Since Greenfield clearly fails to teach an aspirating probe Greenfield does not anticipate the claimed invention.

35 U.S.C. Section 103 Rejections

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Greenfield (U.S. Patent No. 5,891,397). Greenfield does not teach or suggest a combination of an aspirating probe and probe tip. Accordingly, Greenfield does not suggest the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 22 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Greenfield (U.S. Patent No. 5,891,397) in view of DeVaughn et al. (U.S. Patent No. 5,580,529). Reconsideration and withdrawal of the rejection are respectfully requested. Applicants submit that Greenfield fails to teach or suggest the claimed invention for the reason set forth above. Namely, Greenfield does not teach or suggest a probe tip that is adapted to fit onto an aspirating probe as claimed. Instead,

Greenfield teaches a glass slide enclosure assembly for use with microscopes. The fluid coupling allows a view of the fluid being drawn through the ports of the slide assembly. See, e.g., Greenfield at column 1, lines 5-10. Greenfield's teachings are not even remotely related to a probe tip or aspirating probe as claimed.

De Vaughn fails to remedy the defects of Greenfield. The examiner applies De Vaughn as teaching a baffle assembly 23 formed as an adapter which is removably mounted between the reservoir tip and pipetter assembly. The examiner then states "[h]ence, before each new fluid sample is pipetted, the technician could simply replace and discard both pipette tip 16 and adapter assembly 23." Based on this assertion that has no basis in the evidence of record, the examiner then concludes that it would have been obvious at the time of applicants' invention, for the skilled artisan to "recognize" that Greenfield's slide assembly could be employed in the device of De Vaughn to couple a tip and aspiration probe of different diameters together in order to have a disposable tip assembly to reduce cross contamination of fluids.

When a rejection depends on a combination of references, as here, there must be some teaching, suggestion or motivation to combine the references. *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998). That teaching or motivation must come from the references, not the examiner. Here, the examiner has posited that a skilled artisan would have been motivated to make the combination in order to avoid cross contamination of fluids. However, the examiner has failed to point out where in the prior art such motivation exists. Certainly not Greenfield, because Greenfiled is related to slide enclosures. Nor in De Vaughn. De Vaughn is completely silent on the subject. Rejections based on "common sense" as the examiner has advanced in this instance which are not supported by evidence in the record are not sufficient to maintain a rejection based on obviousness. *In re Zurko,* 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

The examination of these claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (732) 524-1496 to clarify any unresolved issues raised by this response.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No. 10-0750/CDS0255/TJB. This sheet is submitted in triplicate.

Respectfully submitted,

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